

April 19, 2006
Case No.: GP-304228 (2760/147)
Serial No.: 10/738,461
Filed: December 17, 2003
Page 8 of 13

REMARKS

The present amendment replies to the Non-Final Office Action dated January 26, 2006. Claims 1-23 are currently pending in the application. Claims 8-14 were withdrawn with traverse in an amendment filed November 9, 2005. New claims 21-23 have been added. No new matter has been added with the amendment.

In the non-final office action, Examiner Tran rejected claims 1-2, 4-5, 7, 15-17, and 20 on various grounds. The Applicants respond to each ground for rejection as subsequently recited herein and respectfully request reconsideration and further examination of the present application under 37 CFR § 1.112.

A. Claims 1-2, 4-5, and 15-17 were rejected under 35 U.S.C § 102(e) as being anticipated by U.S. Patent No. 6,675,008 to Paik et al.

In order for this §102(e) rejection to stand, each and every element of the claimed invention must be disclosed in at least as great detail as claimed. This rejection is traversed. Paik fails to disclose each and every element, and therefore this rejection must fall.

Paik does not disclose “initiating a plurality of call signals *into the mobile module* from a plurality of remote communication devices,” as claimed in claim 1 (emphasis added). Instead, Paik discloses at column 4, lines 34-35 “the present invention includes a plurality of mobile terminals 10a – 10n,” where “*an originating mobile terminal 10a* requests a call connection to a base station 20a. The base station...transmits the call request signal to a mobile switching center” and then, “the selected information...are transmitted to *the terminating mobile terminal 10b*.” See Paik column 9, lines 51-55 and column 10, lines 2-8 (emphasis added).

April 19, 2006
Case No.: GP-304228 (2760/147)
Serial No.: 10/738,461
Filed: December 17, 2003
Page 9 of 13

In addition, Paik does not disclose initiating the plurality of call signals "*based on a timed sequence*" as claimed in claim 1 (emphasis added). Paik, at most, discloses "a terminating mobile terminal 10b continuously checks during an allocated time slot in each paging period whether a terminating signal for the terminating mobile terminal is being transmitted." See Paik column 10, lines 37-41.

Furthermore, Paik does not disclose "*determining which of the plurality of call signals* has established communication with the mobile module" nor does Paik disclose "*terminating the call signals that have not established communication*" as claimed in claim 1 (emphasis added). Instead, Paik discloses "the base station 20a receives the call request signal from the originating mobile terminal 10a and transmits the call request signal to a mobile switching center 30a. Accordingly, the mobile switching center 30a obtains the location of the terminating mobile terminal 10b." See Paik column 9, lines 53-57.

Therefore, Paik does not disclose each and every element of claim 1 and the §102(e) rejection must fall.

Regarding claim 15, Paik does not disclose "*means for initiating a plurality of call signals into the mobile module* from a plurality of remote communication devices *based on a timed sequence* (emphasis added)." Paik discloses a system, at column 4, lines 34-50, including a "base station controller which processes the originating and terminating call signals for the mobile terminals" and "a mobile switching center which...transmits picture information of a mobile terminal user to a terminating mobile terminal."

Therefore, the Examiner's rejection of claim 15 is respectfully traversed.

Regarding claims 2 and 16, Paik does not disclose "*determining whether a call signal in the timed sequence has established communication with the mobile module prior to initiating a next call signal*" (emphasis added). Paik, at most, discloses "the base station 20a receives the call request signal from the originating mobile terminal 10a and transmits the call request signal to a mobile switching center 30a." Therefore, the Examiner's rejection of claims 2 and 16 is respectfully traversed.

April 19, 2006
Case No.: GP-304228 (2760/147)
Serial No.: 10/738,461
Filed: December 17, 2003
Page 10 of 13

Furthermore, contrary to the Examiner's allegations, Paik neither discloses, "each call signal has a call signal position in the timed sequence" as claimed in claims 4 and 17, nor does Paik disclose "the call time increment is a function of the call signal position and a determined time constant" as claimed in claims 5 and 18. Therefore, the Examiner's rejection of claims 4, 5, and 17 is respectfully traversed.

Additionally, claims 2, 4, and 7 depend from claim 1. Claims 2, 4, and 7 are allowable for at least the same reasons as those for claim 1.

Claim 5 depends from claim 4 and is therefore allowable for at least the same reasons as those for claim 4.

Claims 16-18 and 20 depend from claim 15 and are therefore allowable for at least the same reasons as claim 15.

Applicants request withdrawal of the rejection of claims 1-2, 4-5, and 15-17 under 35 U.S.C §102(e).

B. Claims 7 and 20 were rejected under 35 USC § 103(a) as unpatentable over Paik et al in view of U.S. Patent No. 6,311,065, to Ushiki.

The §103(a) rejection of claims 7 and 20 is traversed.

The rationale to modify or combine the prior art may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. MPEP §2144, *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (setting forth test for implicit teachings); *In re Eli Lilly & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985) (examiner must present convincing line of reasoning supporting rejection); and *Ex parte*

April 19, 2006

Case No.: GP-304228 (2760/147)

Serial No.: 10/738,461

Filed: December 17, 2003

Page 11 of 13

Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

The Examiner properly does not cite to any express or implied teachings in either Paik or Ushiki, as neither reference, alone or in combination, provides any such teaching. Therefore, the Examiner must be attempting to rely on either knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. The Examiner makes no citation to any established scientific principles, or precedent established by prior case law, and therefore can only be relying on knowledge generally available to one of ordinary skill in the art.

However, the Examiner provides no evidence of the ordinary skill in the art. In a case such as this, where the Examiner is improperly attempting to combine a caller information transmitting method in a mobile communication network with a mobile communication system for predicting a transfer location of a mobile station, the Examiner's omission of any details regarding the level of skill of one in the art is especially telling. The mere fact that references *can* be combined is not sufficient to establish obviousness under 35 U.S.C. §103(a). *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990), MPEP §2143.01.

The Examiner alleges that "it would have been obvious to one of ordinary skill in the art to use the process of call signal priority to improve the priority of the call in telecommunications systems in light of Ushiki." There is no suggestion in Ushiki to improve "a caller information providing system" as disclosed in Paik. Ushiki discloses a system for predicting a transfer location of a mobile station and discloses a priority wherein "the number of selected candidate cells is increased as the priority of a completed call is higher, and the priority path is set to the candidate cells. Thus, the efficiency and the speed of the handover process are increased as compared to the previously mentioned embodiments." See Column 26, lines 35-40, Ushiki. There is no suggestion that this priority would provide a benefit beyond enhancing the predictive accuracy in a system where a mobile station is moving between communication zones. In fact, Ushiki expressly states that "the probability of the candidate radio communication zone becoming a transferee zone is increased as the call has a higher priority" (see

April 19, 2006
Case No.: GP-304228 (2760/147)
Serial No.: 10/738,461
Filed: December 17, 2003
Page 12 of 13

column 10, lines 34-35, Ushiki) in a "system in which a handover of a mobile station is performed when a completed call is originated while the mobile station is moving." See column 1, lines 7-9 Ushiki.

Additionally, there is no suggestion in Paik that the caller information providing system would include a call priority. Furthermore, Paik does not suggest any basis for determining a call priority, but in fact all calls are handled in a similar manner. Paik teaches "an originating mobile terminal 10a requests a call connection to a base station 20a (step a2). The base station 20a receives the call request signal from the originating mobile terminal 10a and transmits the call request signal to a mobile switching center 30a. Accordingly, the mobile switching center 30a obtains the location of the terminating mobile terminal 10b through the location register and requests a search for the caller identification information of the originating mobile terminal 10a to the picture service controller 40."

Finally, claims 7 and 20 depend from independent claims 1 and 15 respectively and contain all of the elements of the respective independent claim. Therefore, claims 7 and 20 are allowable at least for the reasons as those for claims 1 and 15. Applicants respectfully submit that the rejection of claims 7 and 20 under 35 U.S.C. § 103(a) be withdrawn.

C. New claims

The prior art does not disclose, teach, or suggest each and every element of new claims 21-23, and therefore claims 21-23 are patentable over the prior art. Additionally, claims 21-23 depend directly or indirectly from claim 1, and are therefore patentable over the prior art for at least the same reasons as claim 1. Claim 21 finds support in the specification, *inter alia*, at page 9, line 13. Claim 22 finds support in the specification, *inter alia*, at page 8, line 7. Claim 23 finds support in the specification, *inter alia*, at page 8, line 13.

April 19, 2006
Case No.: GP-304228 (2760/147)
Serial No.: 10/738,461
Filed: December 17, 2003
Page 13 of 13

SUMMARY

Examiner Tran's rejection of claims 1-7 and 15-20 is respectfully traversed based on the above discussion. In addition, reconsideration of non-elected claim 8-14 is requested. The Applicants respectfully submit that claims 1-23 fully satisfy the requirements of 35 U.S.C. §§ 102, 103 and 121. In view of the foregoing remarks, favorable consideration and early passage to allowance of the present application is respectfully requested.

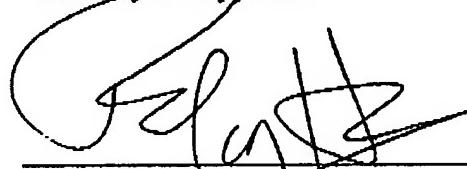
Dated: April 19, 2006

Respectfully submitted,
HITAN S. KAMDAR, et al

GENERAL MOTORS CORPORATION
LEGAL STAFF
MAIL CODE: 482-C23-B21
300 RENAISSANCE CENTER
P.O. BOX 300
DETROIT, MICHIGAN 48265-3000
(313) 665-4714

CARDINAL LAW GROUP
Suite 2000
1603 Orrington Avenue
Evanston, Illinois 60201
Phone: (847) 905-7111
Fax: (847) 905-7113

Anthony Luke Simon
Registration No. 34,434
Attorney for Applicants



Paul M. Hletko
Registration No. 51,806
Attorney for Applicants